

**REMARKS/ARGUMENTS**

Claims 1-36 remain pending in the application. Claims 1-36 are rejected. Through this Response and Amendment, claims 1, 18, 35 and 36 have been amended. No new matter has been introduced into the application. As explained in more detail below, the Applicants submit that all claims are now in condition for allowance and respectfully request such action.

**Interview Summary**

This Interview Summary is filed further to the Examiner's Interview conducted on May 16, 2006.

The patent owner's representatives wish to thank Examiner Tran for the telephone interview on May 16, 2006, during which the pending claims were discussed. During the interview, the patent owner's representatives and the Examiner discussed claim 1 and the prior art, including U.S. Patent Application No. 2003/0043974 to *Emerson, III*. Specifically, Examiner Tran and the patent owner's representative discussed the limitation "transmitting, upon selection, the caller identification to at least one contact from a list of contacts selected from the first user's contact database".

Examiner Tran indicated that a limitation that more clearly indicates the transmitting of the caller identification occurs before attempted communication between the first and the second user would differentiate the pending claims from Emerson. As explained in more detail below, the claims presented in this Response and Amendment recite subject matter that is not taught, disclosed, or suggested in Emerson.

**Rejection under 35 U.S.C. §102**

Claims 1-2, 4-5, 7-9, 15-19, 21-22, 24-26, 32-34 and 36 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by *Emerson, III* (2003/0043974). The Applicants request reconsideration in view of the Remarks below.

Through this Response and Amendment, independent claims 1, 18, 35 and 36 have been amended to have the limitation: "transmitting, upon selection of the caller identification and

before initiating communication with a second user, the caller identification to at least one contact from a list of contacts selected from the first user's contact database". The Specification provides support for these amendments. (See, e.g., Paragraph 1, lines 2 – 3 stating "[A]spects of the invention relate to a method that can be used to deliver selected identification information from one user to another user before communication has been established.").

In contrast, Emerson requires communication between two parties to be initiated or established before transmitting identification information. For example, paragraphs 0039 and 0040 of Emerson set forth the transmission of profile information in a canned message to be transmitted, for example, as combined with E-card, in which the E-card "can be sent to the called system during call setup". (Paragraph 0040; emphasis added). Indeed, transmitting profile information is performed in the context of initiating contact, such as a call, with another user. (*See also* paragraph 0035; stating "user profile information is sent to and exchanged with corresponding systems in the call setup process, particularly in the circumstance of a failed call setup attempt due to the called party not answering"; emphasis added); and paragraph 42 (the E-card may alternatively be "passed to the other party on demand after call setup").

Moreover, there is also no teaching in Emerson of transmitting the first user's selected caller identification "to a list of contacts selected from the first user's contact database". As discussed above, Emerson shows the transmitting of information to a called party. There is no teaching to transmitting the identification to a list of contacts, but rather only to the called party. Therefore, for at least these reasons, the Applicant respectfully requests reconsideration and withdrawal of the rejection.

**Rejection under 35 U.S.C. §103**

Claims 3 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2003/0043974 to *Emerson, III* ("the '974 application") in view of U.S. Pat. No. 6,873,861 to *Awada et al.*, ("the '861 patent"). The Applicants request reconsideration in view of the Remarks below.

As discussed in detail above, Emerson does not disclose at least “transmitting, upon selection of the caller identification and before initiating communication with a second user, the caller identification to at least one contact from a list of contacts selected from the first user’s contact database”. This limitation is not met or otherwise suggested by Awada, which is directed towards transmitting business cards during a phone call. Moreover, claims 3 and 20 further limit the element “selecting, by a first user, a caller identification associated with an identity of the first user” as recited in the claims. In contrast, the cited text of Awada concerns the transmission after a business card has already selected and stored. For at least these reasons, combining Emerson with Awada does not suggest the subject matter of the rejected claims. The Applicant, therefore, respectfully requests reconsideration and withdrawal of the rejection.

Claims 6 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2003/0043974 to *Emerson, III* (“the ‘974 application”) in view of U.S. Patent Publication No. 2002/0052921 to *Morkel* (“the ‘921 application”). The Applicants traverse the rejection in view of the Remarks below.

In response, the Applicant submits the rejected claims are not obvious in view of the cited references as the teaching, motivation, or suggestion to make the claimed combination. As discussed in detail above, Emerson does not disclose Emerson does not disclose at least “transmitting, upon selection of the caller identification and before initiating communication with a second user, the caller identification to at least one contact from a list of contacts selected from the first user’s contact database”. This limitation is not met or otherwise suggested by Morkel. The Office Action asserts that Morkel teaches transmitting the Caller ID to the list of contacts (page 1, para. 0007, page 2, para. 0011, and page 3, para. 0035) for the purpose of securely acquiring, handling, and maintaining contact information (page 1, para. 0002 and 0006). The cited paragraphs do not read upon the rejected claims. For example, claim 6 recites:

The method of claim 1, wherein the step of transmitting, upon selection, the caller identification to a list of contacts selected from the first user’s contact database further comprises:

transmitting the caller identification to the list of contacts through a background transmission process.

In contrast, the cited text of Morkel sets forth that a user can attach a message to an email directed to a recipient indicating that personal information is included in the message (para. 7, 11, and 35). Therefore combining Emerson with Morkel does not suggest the subject matter of the rejected claims, therefore, for at least these reasons the Applicant respectfully requests reconsideration and withdrawal of the rejection. In the alternative, the Applicant requests clarification on where Morkel teaches such a background transmission process and how one skilled in the art would have been motivated to make such a combination.

Claims 10 and 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2003/0043974 to *Emerson, III* ("the '974 application") in view of U.S. Pat. No. 6,442,263 to *Beaton et al.*, ("the '263 patent). The Applicants traverse the rejection in view of the Remarks below.

In response, the Applicant submits the rejected claims are not obvious in view of the cited references as the teaching, motivation, or suggestion to make the claimed combination. As discussed in detail above, Emerson does not disclose Emerson does not disclose at least "transmitting, upon selection of the caller identification and before initiating communication with a second user, the caller identification to at least one contact from a list of contacts selected from the first user's contact database". This limitation is not met or otherwise suggested by Beaton.

Therefore combining Emerson with Beaton does not suggest the subject matter of the rejected claims, therefore, in view of the foregoing, the Applicant respectfully requests reconsideration and withdrawal of the rejection

Claims 11-14 and 28-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2003/0043974 to *Emerson, III* ("the '974 application") in view of U.S. Patent Publication No. 2003/0083086 to *Toiyryla et al.*, ("the '086 application"). The Applicants traverse the rejection in view of the Remarks below.

In response, the Applicant submits the rejected claims are not obvious in view of the cited references as the teaching, motivation, or suggestion to make the claimed combination. As discussed in detail above, Emerson does not disclose Emerson does not disclose at least "transmitting, upon selection of the caller identification and before initiating communication

with a second user, the caller identification to at least one contact from a list of contacts selected from the first user's contact database". This limitation is not met or otherwise suggested by Toyryla. Indeed, the cited text merely states that groups "may be created and managed by sending standard messages, *i.e.* in a way similar to distributing electronic business cards (and ringtones and logos)." (Page 3, para. 0042). Merely teaching that groups may be created by sending standard messages does not teach or otherwise suggest the subject matter of the rejected claims. Therefore, the Applicant respectfully requests reconsideration and withdrawal of the rejection.

Claim 35 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2003/0043974 to *Emerson, III* ("the '974 application") in view of U.S. Pat. No. 5,889,852 to *Rosecrans et al.*, ("the '852 patent"). The Applicants traverse the rejection in view of the Remarks below.

In response, the Applicants submit the rejected claims are not obvious in view of the cited references as the teaching, motivation, or suggestion to make the claimed combination. The limitations of Emerson have been described above. These limitations are not met or otherwise satisfied by the teachings of Rosecrans. Rosecrans is directed towards telephones containing phonebooks and graphical user interfaces for displaying such phonebooks. As provided in the Summary of the Invention, "[t]he present invention is directed to a Graphical User Interface, for use with electronic phonebooks, that links graphical information, e.g. a graphic identifier such as a logo or a picture, to a phone number that may be called using the graphic identifier when displayed on the interface. (Col. 1, lines 60 – 65; emphasis added). While one user may send/receive a photo or logo from another user, the photo or logo is not used for a Caller ID related function when a call is placed. Rather, the teachings of Rosecrans allow a user to choose a picture or logo (which may have been received from another user) representing a person or business to place a call rather than choosing the actual collection of digits comprising the phone number to call. In this regard, Rosecrans allows the calling party to review and possibly select the picture or logo and does not teach or otherwise suggest the subject matter of the rejected claim. In this regard, there is no teaching or motivation to combine the references, and upon doing so, the subject matter of the rejected claims is not taught or otherwise suggested.

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Therefore, for at least these reasons, the Applicant respectfully requests reconsideration and withdrawal of the rejection.

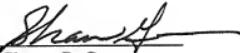
**CONCLUSION**

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the number set forth below.

Respectfully submitted,  
**BANNER & WITCOFF, LTD.**

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By:   
Shawn P. Gorman  
Reg. No. 56,197

BANNER & WITCOFF, LTD.  
10 South Wacker Drive  
Suite 3000  
Chicago, IL 60606  
Tel: (312) 463-5434  
Fax: (312) 463-5001